

REMARKS

Applicants submit the following remarks in reply to the Final Office Action mailed on October 18, 2006. In the Final Office Action, the Examiner¹ rejects claims 1-11 under 35 U.S.C. § 102(e) as being anticipated by Jonathan B. Rosenberg, How Debuggers Work, September 27, 1996, Wiley Computer Publishing ("Rosenberg"), and rejects claims 12-27 under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg. Claims 1-27 remain pending in the present application.

I. Claim Rejections Under 35 U.S.C. § 102(e)

On pages 2-3 of the Office Action, the Examiner rejects claims 1-11 under 35 U.S.C. § 102(e)² as being anticipated by Rosenberg. Applicants respectfully traverse these rejections.

In order to support a rejection under 35 U.S.C. § 102(e), each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. Rosenberg fails to teach each and every element of claim 1.

Independent claim 1 recites a combination including, *inter alia*, "[a] method for debugging a first computer program code by using debugging software, the method comprising: including breakpoint computer program code within the first computer

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

² Although the Examiner rejects the claims under 35 U.S.C. § 102(e), it appears that this is in error and that based on the cited reference, the Examiner should have applied 35 U.S.C. § 102(b).

program code, the breakpoint computer program code referring to one or more conditional breakpoints."

The Examiner cites to page 25, Fig. 2.4 of Rosenberg as disclosing this feature. This section of Rosenberg shows a debugger that includes executable code and includes certain standard breakpoints. The Examiner asserts that these breakpoints are conditional because the executable code includes the following:

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"if (key >= '0' && key <= 'g') {  
    checkFirst ();...  
    else if ..."
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Final Office Action at 3. This assertion is incorrect. Although Rosenberg may disclose breakpoints and conditional breakpoints, Rosenberg fails to disclose including breakpoint computer program code "within" a first computer program code, wherein the breakpoint computer program code is "referring to one or more conditional breakpoints," as recited in claim 1. The breakpoints shown in Fig. 2.4 are not disclosed or suggested to be conditional breakpoints. Rather, they are standard breakpoints placed into a particular line of code to cause the executable to stop at a point in the code. The "if" statements cited by the examiner are the *executable code* itself and do not constitute conditional breakpoints. Thus, Rosenberg fails to disclose at least "including breakpoint computer program code within the first computer program code, the breakpoint computer program code referring to one or more conditional breakpoints," as recited in claim 1.

Since Rosenberg fails to teach each and every element of claim 1, claim 1 and claims 2-11, which depend therefrom, are not anticipated by Rosenberg. The rejection under 35 U.S.C. § 102 is therefore improper and should be withdrawn.

II. Claim Rejections Under 35 U.S.C. § 103(a)

On pages 3-4 of the Office Action, the Examiner rejects claims 12-27 under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg. Applicants respectfully traverse these rejections. No *prima facie* case of obviousness has been established.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128. A *prima facie* case of obviousness has not been established for at least the reason that the cited art fails to teach each and every element of claims 12 and 23.

As noted above, Rosenberg fails to teach each and every element of claim 1. Independent claims 12 and 23, although different in scope from independent claim 1, include elements similar to those discussed above in connection with claim 1. Thus, Rosenberg also fails to teach each and every element of claims 12 and 23. No *prima facie* case has been established with respect to claims 12 and 23, or with respect to claims 13-22, 24, 26, and 27, which depend therefrom. Additionally, no *prima facie*

case has been established with respect to claim 25, which depends from claim 1.

Accordingly, the rejection of claims 12-27 is improper, and should be withdrawn.

III. Conclusion

In view of the foregoing remarks, the pending claims are neither anticipated nor rendered obvious in view of the prior art references cited against this application.

Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of all of the claims.

If a telephone interview will expedite issuance of this application, the Examiner is requested to call Applicants' representative, whose name and registration number appear below, to discuss any remaining issues.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: December 19, 2006

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